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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,131	07/21/2006	James E. Price	PHIT8686	6155

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POLSTER, LIEDER, WOODRUFF & LUCCHESI
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ST. LOUIS, MO 63131-3615

EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3772

MAIL DATE	DELIVERY MODE
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10/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,131

Applicant(s)

PRICE ET AL.

Examiner

Kim M. Lewis

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed 8/9/07 has been received. No claims were amended.
2. Claims 1-11 are pending in the instant application.

Response to Arguments

3. Applicant's arguments filed 8/9/07 have been fully considered but they are not persuasive. Applicant primarily argues that the examiner has not established a *prima facie* case of obviousness as required under law and in accordance with the MPEP since the examiner has not shown that all elements of any of claims 1-11 are found in Carmody, or in the combination of Dow or Smith. Applicant concludes that none of the cited references disclose "an absorbent pad having a bottom side and a top side, the top side having a non-toxic pigmented composition applied to it" or the step of "applying a non-toxic pigment to the top side of the pad".

The examiner disagrees with applicant's assessment of the rejection and the combined prior art. First, applicant should note all elements of claims 1-11 are found in the cited prior art. Second applicant is reminded that while the factual inquiries in *Graham* are still the basis for determining obviousness under 35 U.S. C. 103, the Supreme Court, in the KSR decision, found that the Federal Circuit's Teaching, Suggestion or Motivation (TSM) test improperly

Art Unit: 3772

transformed the general principles of the obviousness analysis into a rigid rule. Thus, KSR forecloses the argument that a specific TSM is required to support a finding of obviousness. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).

In response to applicant's arguments the examiner contends that ***while the "pigmented plastic strip" of Carmody is different from the pigmented composition disclosed in the specification, the pigmented plastic strip is still a pigmented composition that is applied to absorbent pad (16).*** The features not taught by Carmody are a ***non-toxic*** pigmented composition and a ***transparent*** adhesive.

As to the transparent adhesive, the examiner relies on Smith for teaching this feature. In substituting the adhesive of Smith for the adhesive of Carmody, the predictable result of allowing the pigmented plastic to be clearly visible so as to render the bandage inconspicuous as it matches the skin tone of the user, would have been obvious to one having ordinary skill in the art.

As to the non-toxic pigmented composition, Dow discloses a non-toxic pigmented composition coated on a backing layer and an absorbent pad attached to the bottom side of the backing layer, thereby teaching a non-toxic pigmented composition applied to the pad as well. Here, the simple substitution of one pigmented element for another to obtain the predictable result of rendering the bandage safe for use would have been obvious to one having ordinary skill in the art.

Art Unit: 3772

4. Applicant also concludes that the elimination of the "pigment plastic strip" is indicia of obviousness since the function of matching the skin tone of the user is maintained. The examiner disagrees. While applicant's claims do not require a pigmented plastic strip, an equivalent element, *e.g.*, the pigmented composition is used to accomplish the function of matching the skin tone of the user. Thus, the pigmented composition is substituted for the pigmented plastic strip. Applicant is reminded that the substitution of one known element for another to obtain predictable results is within the skill of art.

The rejections outlined in the office action mailed, 4/9/07 are maintained and repeated below.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmody in view of Dow and U.S. Patent No. 2,905,174 ("Smith").

As regards claim 1, Carmody disclose a bandage for cosmetic use, thereby being a cosmetic bandage. The bandage comprises a transparent backing (10), a pressure sensitive adhesive (12), a pad (16) and a pigmented plastic strip, which lays on top of the pad.

Carmody fails to teach that the adhesive is transparent and that the pigment is non-toxic. As to the transparent adhesive, Smith teaches it is conventional in the art to provide adhesive bandages having pigment therein with transparent

Art Unit: 3772

adhesive for the inherent purpose of being invisible to the eye so render the bandage inconspicuous.

In view of Smith, it would have been obvious to one having ordinary skill in the art to use a transparent pressure sensitive adhesive for the purpose of rendering the adhesive invisible to the eye so render the bandage inconspicuous.

As to the non-toxic pigment, Dow, Jr. discloses a color matched adhesive bandage comprising a non-toxic pigment to inherently insure that the user is not poisoned by the pigment.

In view of Carmody, it would have been further obvious to substitute the colored plastic strip (14) of Carmody for the non-toxic pigment of Dow, Jr. to insure that the user is not poisoned by the pigment.

As regards claim 2, note the disclosure of the use of pressure sensitive adhesive at col. 2, line 9 of Carmody.

As regards claim 3, note removable strips (18) of Carmody.

As regards claim 4, Carmody fails to teach a plurality of pigments are blended to match the skin. However, Dow, Jr. at col. 3, lines 63-66 discloses the use of a plurality of colors (pigments) in order to achieve the desired color to match the skin. In view of Dow, Jr., it would have been obvious to one having ordinary skill in the art at the time the invention was made to blend a plurality of colors (pigments) to achieve the desired color of the colored strip (14) of Carmody in order to match the skin.

As regards claim 5, Carmody fails to teach that the color is embedded in the pad. Absent a critical teaching and/or showing of unexpected results derived

from use of embedded the pigment in the pad, the examiner contends that any means for providing color to the bandage of Carmody to achieve the desired result of matching the bandage to the skin is an obvious design choice which does not distinguish applicant's invention.

Regarding claim 6, as can be seen from Figs. 2 and 4, when the components of the bandage are joined together, pigmented (colored) strip (14) lays on (coated on) the top of the pad.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,687,136 ("Carmody").

As regards claim 7, Carmody discloses a bandage and inherently discloses the claimed method of constructing the bandage. As can be seen from Fig. 4 and as can be read from col. 2, Carmody discloses applying a pigment in the form of a colored plastic strip (14) to a transparent backing (10). Carmody fails to teach that the pigment is a non-toxic pigment. However, Dow, Jr. discloses a color matched adhesive bandage comprising a non-toxic pigment to inherently insure that the user is not poisoned by the pigment.

In view of Carmody, it would have been obvious to substitute the colored plastic strip (14) of Carmody for the non-toxic pigment of Dow, Jr. to insure that the user is not poisoned by the pigment.

As regards claim 8, the adhesive must be applied to the backing before attaching pad (16) in order that pad (16) remains adhered to the backing.

As regards claim 9, note removable strips (18).

As regards claims 10 and 11, the steps of applying the pigment to the by a silk

Art Unit: 3772

screening process or a flood printing process is neither disclosed nor taught by Carmody. Absent a critical teaching and/or a showing of unexpected results derived from applying the pigment to the pad by a silk screening process or a flood printing process, the examiner concludes that the process by which the pigment (color) is added to the pad is an obvious design choice, which does not distinguish applicant's invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kim M. Lewis
Primary Examiner
Art Unit 3772

kml
October 17, 2007